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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/089,815	07/01/2002	Jonathan Sharp	042933/299147	5578
826	7590	05/16/2006		
ALSTON & BIRD LLP BANK OF AMERICA PLAZA 101 SOUTH TRYON STREET, SUITE 4000 CHARLOTTE, NC 28280-4000			EXAMINER	PHU, SANH D
			ART UNIT	PAPER NUMBER
			2618	

DATE MAILED: 05/16/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	10/089,815	SHARP, JONATHAN
	Examiner	Art Unit
	Sanh D. Phu	2618

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 20 March 2006.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 14,15,20 and 23-40 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 14,15,20,23-39 is/are rejected.
- 7) Claim(s) 40 is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date: _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date: _____ | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This Office Action is responsive to the Amendment filed on 3/20/06.

Accordingly, claims 14, 15, 20 and 23-40 are currently pending, and claims 1-13, 16-19, 21 and 22 were canceled.

Claim Rejections – 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is

determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

3. Claims 14, 15, 20 and 23–39 are rejected under 35 U.S.C. 102(e) as being anticipated by Kato et al (6,297,795), newly-cited.

–Regarding to claim 14, Kato et al discloses a portable device (see figure 4) comprising:

a user input comprising a key (12) having a first function of performing a shortcut to a predetermined menu, e.g., “Text/PIM Browser Ver 1.0” when the device is in a first state “initial mode (main menu)” (when the portable device is powered on) (see col. 10, lines 48–51) and a second function, e.g., for navigating, selecting or setting around menu items (as shown in figure 12), when the device is not in the first state;

a processor (20) (see figure 5) for determining the state of the device and for performing a function in response to a first mode of operation of the key, e.g., one of “rotation”, “pressing” “continuous pressing” and “pressing and rotation” (see col. 8, line 66 to col. 9, line 6, col. 10, lines 25–30); and

wherein the second function is capable of performing a shortcut to the first state “main menu”, e.g., as shown in figure 12, if the key (12) is moved to “SET”, the second function will perform returning to the first state “main menu” (see col. 11, lines 53–58), and the predetermined menu comprises a list of first level menu items, e.g., 6 first level menu items being shown in figure 12.

–Regarding to claim 15, in Kato et al, the initial mode (main menu) can be considered here equivalent with the limitation “idle state”.

–Regarding to claims 23, 32, 33, Kato et al discloses that the key has a third function, e.g., for navigating, selecting or setting around menu items and the processor performs the third function (see col. 8, line 66 to col. 9, line 6) in response to a second mode of operation of the key e.g., one of “rotation”, “pressing” “continuous pressing” and “pressing and rotation” (see col. 8, line 66 to col. 9, line 6).

–Regarding to claims 20, 34, Kato et al discloses that the first level menu items include settings (see figure 12).

–Regarding to claim 24, Kato et al discloses that the third function is associated with a second state of the device (see figure 12); the key has a

fourth function, for navigating, selecting or setting around menu items, associated with a third state of the device, e.g., one of states “Ashahi Flash New”, National News”, “Sport News”, Editoria”, “Column” and “Weather Report” (see figure 9); and

the processor performs third or fourth functions in response to the second mode of operation of the key, depending upon a state of the device (see col. 10, lines 25–30).

-Regarding to claims 25, 26, Kato et al discloses that the processor determines a mode of operation of the key by a duration of operation, e.g., momentarily pressed (see col. 14, lines 63–66).

-Regarding to claims 27, 28, Kato et al discloses that a first mode of operation has a duration less than a predetermined threshold, e.g., less than two seconds in order to make the key momentarily pressed being distinguishable from continuously pressed (see col. 8, lines 66–67, col. 9, lines 27–31, col. 14, lines 63–66).

-Regarding to claim 29, Kato et al discloses that the key is a button (see (12) of figure 4).

-Regarding to claim 30, Kato et al discloses that one of the functions of the key is to turn off the device (see col. 9, lines 27–31).

-Regarding to claim 31, Kato et al discloses that the portable device can be a radiotelephone (see col. 17, lines 8–12).

-Regarding to claim 35, Kato et al discloses that the key is provided by a position of a multi-positional device (see (12) of figure 4).

-Regarding to claim 36, Kato et al discloses that the multi-positional device is a roller (see (12) of figure 4).

-Regarding to claim 37, as similarly applied to claim 14, Kato et al discloses a method comprising:

step (12) (see figure 4) of actuating a user input comprising a key (12) having a first function of performing a shortcut to a predetermined menu when the device is in a first state, actuating the user input when the device is not in the first state, the key having a second function when the device is not in the first state;

one of the first function and the second function being performed in response to a first mode of operation of the key and upon determining the state of the device; and

wherein the second function of the user input is performing a shortcut to the first state, and wherein the second function of the user input is performing a shortcut to the first state, and the predetermined menu comprises a list of first level menu items.

-Regarding to claim 38, as similarly applied to claim 14, Kato et al discloses computer program comprising program instructions for operation of a portable device and when loaded onto a processor (20) (see figures 5, 6, col. 10, 48-52), causing the processor to perform the steps of :

detecting actuation of a user input comprising a key having a first function of performing a shortcut to a predetermined menu when the device is in a first state and a second function when the device is not in the first state;
determining the state of the device;
selecting one of the first function and the second function in accordance with the determined state of the device, and

performing the selected function in response to a first mode of operation of the key; and

wherein the second function of the user is input is performing a shortcut to the first state, and the predetermined menu comprises a list of first level menu items.

-Regarding to claim 39, Kato et al discloses that a physical entity (EEPROM 25) embodying the computer program (see col. 10, lines 50–52).

Allowable Subject Matter

4. Claim 40 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

-Regarding to claim 40, Kato et al fails to further teach an electromagnetic carrier signal carrying the computer program.

Response to Arguments

5. Applicant's arguments filed on 3/20/06 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, THIS ACTION IS MADE FINAL. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sanh D. Phu whose telephone number

is (571)272-7857. The examiner can normally be reached on M-Th from 7:00-17:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Matthew D. Anderson can be reached on (571) 272-4177. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Sanh d. Phu
Examiner
Division 2618



Matthew Anderson
SPE 2618